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10/796,718	03/08/2004	Patrice M. Fabre	027385-000200US	1798
20350 7590 06/28/2010 TOWNSEND AND TOWNSEND AND CREW, LLP TWO EMBARCADERO CENTER EIGHTH FLOOR SAN FRANCISCO, CA 94111-3834				
EXAMINER RICEK, JASON D				
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Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

10/796,718

Applicant(s)

FABRE ET AL.

Examiner

JASON RECEK

Art Unit

2442

Period for Reply -- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 09 April 2010.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-14, 20-23 and 25-31 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-14, 20-23 and 25-31 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/SB-06)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date _____
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____

DETAILED ACTION

This is in response to the amendment filed on April 9th 2010.

Status of Claims

Claims 1-14, 20-23 and 25-31 are pending.

Response to Arguments

1. Applicant's arguments, see pg. 10-13, filed 4/9/10, with respect to the rejection(s) of claim(s) 1 and 20 under 103(a) have been fully considered and are persuasive. Therefore, the rejection has been withdrawn. However, upon further consideration, a new ground(s) of rejection is made in view of Moody et al. US 7,412,437 B2.

Claim Rejections - 35 USC § 103

2. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.
3. Claims 1-14, 20-23, 25 and 27-28 are rejected under 35 U.S.C. 103(a) as being unpatentable over Du US 7,231,427 B1 in view of Knox et al. US2007/0005762 A1 and Moody et al. US 7,412,437 B2.

Regarding claim 1, Du discloses "an internal e-mail facility ... for facilitating and tracking e-mail communications between (i) an end user ... and (ii) an external contact" as a mail server that operates between subscribers and non-subscribers (abstract, Fig. 1),

"sending an initial e-mail from said internal e-mail facility to the external contact, wherein a domain of a REPLY-TO field ... corresponds to a domain of said internal e-mail facility" (reply field of Fig. 1 contains domain of mail server), "a local part of said REPLY-TO field of said initial email message comprises a tracking string ... associated with said end user" a portion of the reply field is changed in order to conceal the email address and is also used to archive (i.e. track) the email (Figs. 1-2, 6, col. 2 In. 8-18, col. 3 In. 1-13),

"receiving at said internal e-mail facility a first reply e-mail message from said external contact" (col. 2 In. 53-58), "having a TO field including said tracking string" email is addressed to the server having the address inserted by the server which includes the data for tracking (col. 2 In. 46-59),

"sending from said internal e-mail facility a modified version of said first reply e-mail message to a native e-mail address of the end user" intermediate server modifies email and forwards to native address (col. 2 In. 60-64), "a domain of a REPLY-TO field of said modified version ... corresponds to said domain of said internal e-mail facility" system changes reply-to address (col. 2 In. 63-64), and "a local part of said REPLY-TO field comprises a first modified version of said tracking string" reply-to field is modified (col. 2 In. 63-67), the intermediate server uses this portion of the reply field to archive

emails (col. 3 ln. 11-13), which allows the user to track an email conversation (col. 3 ln. 14-15).

Du does not explicitly disclose "a tracking string encoding tracking information" rather the information contained in the reply-to fields of Du is used for privacy and archiving the emails (Fig. 6, col. 3 ln. 11-13). However, Knox explicitly teaches inserting a tracking code into an email (paragraphs 6-7).

It would have been obvious to one of ordinary skill in the art at the time of the invention to modify Du such that the tracking string contained tracking information as disclosed by Knox for the purpose of monitoring email. Du already teaches inserting a string in the reply-to field for archiving email conversations between a sender and receiver. Knox further suggests it is desirable to monitor the behavior of an email recipient (paragraph 4).

The combination of Du and Knox does not explicitly disclose "a first tracking string component uniquely identifying a thread of conversation between said end user and said external contact and a second tracking string component that orders messages in the thread of conversation" however this is taught by Moody as a threading service that determines (uniquely identify) a conversation thread among a set of emails (col. 2 ln. 19-28, col. 3 ln. 57 – col. 4 ln. 6) and orders messages in the conversation thread (col. 2 ln. 29-33, col. 8 ln. 33-39). It would have been obvious to one of ordinary skill in the art at the time of the invention to modify the combination of Du and Knox with

the threading service taught by Moody for the purpose of tracking emails. Moody suggests that by using a threading service it is easier to search for messages and provide a user with related conversations (col. 1 ln. 37-49). Du also teaches that emails related to the same person are grouped together in chronological order (col. 4 ln. 54-64).

Regarding claim 2, Du discloses "archiving said first reply e-mail message" (col. 5 ln. 9-22).

Du does not explicitly disclose "generating a first metadata object based on said tracking string" or "metadata object associates [...] said end user, said external contact, and at least one business functionality", however this is taught by Knox as generating a cookie based on tracking information (paragraph 20), and associating who sent the email, the recipient and the behavior (business information) of the recipient (paragraph 26). Motivation to combine is the same as that given above.

Regarding claim 3, Du does not explicitly disclose "generating a viewable communication log screen including information derived from said first metadata object" however this is taught by Knox as displaying information from the metadata object to a user (paragraphs 40-41).

Regarding claim 4, Du discloses "second reply e-mail message having a TO field including said first modified version of said tracking string" when the original sender

replies to the reply the process will repeat and the TO-field will contain the modified tracking string because when a user replies the contents of the reply-to field are copied to the to field (col. 4 ln. 5-30), and

“sending a modified version of said second reply e-mail message to the external contact, wherein a domain of a REPLY-TO field of said modified version of said second reply e-mail message corresponds to said domain of said internal e-mail facility, and wherein a local part of said REPLY-TO field comprises a second modified version of said tracking string” reply-to and to field contain domain of e-mail facility and tracking strings inserted by intermediate server (Figs. 1-2).

Regarding claim 5, it corresponds to claim 2 but recites a second iteration. Therefore it is rejected for similar reasons.

Knox discloses “generating a second metadata object based on said second modified version of said tracking string” as generating a secondary cookie (paragraph 32) which performs the same functions as the first such as: “associates said second reply e-mail message with said end user, said external contact, and said at least one business functionality” (paragraph 26).

Regarding claim 6, Du does not explicitly disclose “generating a viewable communication log screen including information derived from said first metadata object and said second metadata object” however this is taught by Knox as displaying information from the metadata objects to a user (paragraphs 40-41, 43).

Regarding claim 7, Du does not explicitly disclose "native e-mail system of said end user is a web-hosted e-mail service" however this is taught by Knox as a web-based email (paragraph 15).

Regarding claim 8, Du does not explicitly disclose "native e-mail system of said end user is a dedicated desktop e-mail application" however this is taught by Knox as a application email program (paragraph 15).

Regarding claim 9, Du does not explicitly disclose "internal e-mail facility is operated out of a same Internet domain as said web-based business information system" however this is taught by Knox as a user sending email from his business association which is associated with a single domain (paragraph 15).

Regarding claim 10, Du does not explicitly disclose "initial e-mail message comprises a message body manually composed by the end user" however this is taught by Knox as a user composing an email (paragraph 15).

Regarding claim 11, Du discloses "initial e-mail message is automatically sent on behalf of the end user by said web-based business information system" as a server which sends an email (col. 2 ln. 44-45).

Regarding claim 12, Du discloses "REPLY-TO field of said initial e-mail message further comprises a display name for said end user that is substantially identical to a display name associated with said end user in said native e-mail system" (Fig. 1).

Regarding claim 13, Du discloses "subscribed to by a business enterprise" as users subscribe (col. 2 ln. 8-11). Knox also discloses "web-based business information system is provided by an application service provider and subscribed to by a business enterprise" as a business user whose email is provided by a service provider such as Yahoo (paragraph 15).

Regarding claim 14, Du does not explicitly disclose "web-based business information system is self-hosted by a business enterprise" however this is taught by Knox as a business which owns the domain and thus the email system is 'self-hosted' (paragraph 15).

Regarding claim 20, it is similar to claim 1, those similar parts are rejected for the same reasons given in the rejection of claim 1. Claim 20 adds the limitations "first thread-recurrent field of said initial e-mail message comprises a tracking string" and "a second thread-recurrent field" that comprises a "first modified version of said tracking string". Thread recurrent fields are disclosed by Knox as subject fields of an email (Fig. 2). It would have been obvious to one of ordinary skill in the art at the time of the

invention to modify Du and Knox by adding a tracking string to a subject field of an email. That technique is well known in the art and yields predictable results.

The combination of Du and Knox does not explicitly disclose "the second tracking information component is modified and the first tracking information component is unmodified" however this suggested by Moody as a threading service that determines if messages are part of a thread (col. 8 ln. 20-28). It would have been obvious that the component responsible for ordering messages is modified. Moody discloses ordering by date (col. 8 ln. 37-38).

Regarding claim 21, it is identical to claim 2 and is therefore rejected for the same reasons.

Regarding claim 22, it is substantially similar to claim 4 and the similar parts are thus rejected for the same reasons. Claim 22 adds the limitation "thread-recurrent field". As discussed in the rejection of claim 20 Knox discloses thread recurrent fields (Fig. 2).

Regarding claim 23, it is identical to claim 18 and is therefore rejected for the same reasons.

Regarding claim 25, Du does not explicitly disclose "said first, second, and third thread-recurrent fields are each SUBJECT fields" however this is taught by Knox as

subject fields in an email (Fig. 2). As discussed in claim 20, it is well known to place tracking information in a subject field of an email.

Regarding claim 27, it is similar to claim 1, those similar portions are rejected for the same reasons previously given.

Du discloses "evaluating one or more rules to access rules-based e-mail tracking functionality" (col. 4 ln. 53-58).

The combination of Du and Knox does not explicitly disclose "a distinguished communications category" however this is taught by Moody as messages related by topic (col. 8 ln. 55-60) and using a profile to track messages (col. 8 ln. 61-64).

Regarding claim 28, it corresponds to claim 4, therefore the corresponding parts are rejected for similar reasons.

Du suggests "category is general correspondence" as a folder of messages between users (col. 4 ln. 53-60). Moody also discloses "distinguished communications category is general correspondence" as using names to sort messages, thus general correspondence between two users would be grouped (col. 8 ln. 55-67).

4. Claim 26 is rejected under 35 U.S.C. 103(a) as being unpatentable over the combination of Du, Knox and Moody and in view of Bargagli Damm et al. US 2004/0006598 A1.

Regarding claim 26, the combination of Du and Knox does not disclose "said first, second and third thread-recurrent fields are encrypted into body fields of said initial e-mail message" however encryption of email objects is taught by Bargagli Damm (paragraph 98) including encryption of an email header (paragraph 105).

It would have been obvious to one of ordinary skill in the art at the time of the invention to modify the combination of Du and Knox by adding encryption taught by Bargagli Damm for the purpose of security. Encryption is well known in the art and provides predictable results.

5. Claim 29 is rejected under 35 U.S.C. 103(a) as being unpatentable over the combination of Du, Knox and Moody and in view of Brechner et al. US 2003/0144903 A1.

Regarding claim 29, the combination of Du, Knox and Moody does not explicitly disclose the category identified "is trouble tickets" or "tracking functionality comprises helpdesk functionality" however this is taught by Brechner as inserting a tracking code into e-mail for the purpose of help/support information (paragraph 113). It would have been obvious to one of ordinary skill in the art at the time of the invention to modify the combination of Du, Knox and Moody to be use for help support. Using e-mail for help support is well known in the art (as evidenced by Brechner). Thus this is merely the

combination of known elements according to their established function in order to yield a predictable result.

6. Claims 30-31 are rejected under 35 U.S.C. 103(a) as being unpatentable over the combination of Du, Knox and Moody and in view of Reisman US 2004/0186738 A1.

Regarding claim 30, the combination of Du, Knox and Moody does not explicitly disclose "the second e-mail message is invitation replies, and the rules-based e-mail tracking functionality comprises business event organizing functionality" however this is taught by Reisman as people becoming involved in marketplace activities by joining as participants (paragraphs 58-59), the marketplace is for business event organization (paragraph 41). It would have been obvious to one of ordinary skill in the art at the time of the invention to modify the combination of Du, Knox and Moody with the business functionality taught by Reisman for the purpose of collaborating. Collaboration using electronic messages is well known in the art (as evidenced by Reisman). Thus, this is merely the combination of known elements according to their established function in order to yield a predictable result.

Regarding claim 31, the combination of Du, Knox and Moody does not explicitly disclose "setting calendar appointments corresponding to positive invitation replies, and altering resource allocations for a business event based at least in part on a number of

positive invitation replies" however this is taught by Reisman as adjusting schedules (setting calendar appointments) based on feedback (paragraphs 106-108, Fig. 3).

Conclusion

7. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

Durazo et al. US 2005/0004990 A1 discloses grouping email messages by conversation thread (abstract, Fig. 4).

Harvey et al. US 6,784,901 B1 discloses tracking a thread of conversation and ordering based on oldest to newest (col. 2 In. 60-65).

8. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of

the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to JASON RECEK whose telephone number is (571)270-1975. The examiner can normally be reached on Mon - Fri 9:00am-5:30pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Philip Lee can be reached on (571) 272-3967. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

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